

Attorney Docket No. 31735/70009
PATENT

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Michael R. DUFF et al. Conf. No.: 8141
Serial No.: 10/645,844 Art Unit: 1615
Filed: August 22, 2003 Examiner: Ghali, Isis A. D.
For: METHOD AND APPARATUS FOR DECREASING THE
DROWSINESS OF AN INDIVIDUAL

PETITION UNDER 37 CFR 1.144

Honorable Commissioner for
Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is a petition in response to the office action mailed May 27, 2004 wherein the requirement for restriction is repeated and made final. Applicant elected with traverse in the response filed April 28, 2004.

The restriction requirement.

At page 2 of the above-noted office action applicant's traverse of the requirement for restriction is responded to by stating that "while the groups seem to be overlapping this does not indicate the search would not be extensive because the patent examiner searches the databases mostly literally... [t]he reference that anticipates one group not necessary anticipates the other groups...[and] [t]he search system and the focus of the invention are completely different, requiring an undue burden on the patent examiner." The requirement is made final.

The April 16, 2004 requirement finds inventions I, II and III unrelated based on two grounds,

1. "[i]nventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects...."
2. "[i]n the instant case the different inventions are disclosed as capable of use separately."

Both grounds were challenged in applicant's traverse of the requirement (filed April 28, 2004). The first above quoted reason for making the requirement final that "the search would not be extensive..." is not a reason addressing whether the claims in categories I, II and III are capable of use together and they have different modes of operation, different functions, or different effects (ground I above) and is not a reason addressing whether the claims in categories I, II and III are disclosed as capable of use separately (ground II above).

The second reason that "[t]he reference that anticipates one group not necessary anticipates the other groups" is not directed to either of the above grounds 1 and 2. No specific reference is cited and this quoted reason does not explain how the claims of groups I, II and III satisfy the criteria of ground 1 and this is not a reason addressing whether the claims in categories I, II and III are disclosed as capable of use separately (ground II above).

The last reason states "[t]he search system and the focus of the invention are completely different, requiring an undue burden on the patent examiner." This is not an explanation of how grounds 1 and 2 above are satisfied.

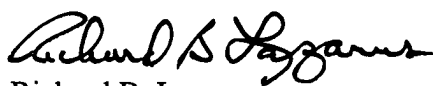
With respect to ground 2 above, applicant again states that nothing in applicant's disclosure states that the claims in categories I, II and III are disclosed as capable of use separately.

A requirement for restriction is proper where there are two or more independent and distinct inventions (see 37 CFR 1.141 and 1.142). The present requirement has not established that claims 41-50 include independent and distinct inventions. The above reasons for the requirement, extensive search, a hypothetical anticipatory prior art reference, and undue burden on the examiner are not reasons that explain how the present claims (Nos. 41-50) include independent and distinct inventions.

For all of the above reasons, applicant urges that the restriction is not proper and should be withdrawn. Action on all of applicant's claims (Nos. 41-50) is requested.

It is respectfully requested that, if necessary to effect a timely response, this paper be considered as a Petition for an Extension of Time sufficient to effect a timely response and that shortages in fees, if any, be charged, or any overpayment in fees credited, to the Account of Barnes & Thornburg, Deposit Account No. 10-0435 (31735/70009).

Respectfully submitted,
BARNES & THORNBURG



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